

Attorney's Docket No.: 08895-006001

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3/26/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Marshall Medoff et al.

Art Unit : 1771

Serial No. : 09/338,209

Examiner : Jenna-Leigh Befumo

Filed : June 22, 1999

Title : TEXTURIZED FIBROUS MATERIALS FROM POLY-COATED PAPER AND COMPOSITIONS AND COMPOSITES MADE THEREFROM

Commissioner for Patents  
Washington, D.C. 20231

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RESPONSE TO OFFICE ACTION MAILED OCTOBER 24, 2001

Claims 7, 10, and 11 are pending. In response to the action mailed October 24, 2001, please consider the following remarks.

Rejection under 35 U.S.C. § 112

Claims 7, 10, and 11 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Specifically, the Office Action argues that the phrase "internal fibers are substantially exposed" renders claim 7 indefinite. Applicants respectfully traverse this rejection. Claim 7 is directed to poly-coated paper that has been sheared to the extent that its internal fibers are substantially exposed. Poly-coated paper is, as the name implies, paper that is coated with a polymer. Although paper is by its nature fibrous, the polymer coating prevents the poly-coated paper's fibers from being substantially exposed. This coating is one reason that one is able to store milk or orange juice, for example, in poly-coated paper cartons without the paper fibers soaking up the liquid.

Applicants discovered that a novel, unexpectedly fluffy material can produced by shearing poly-coated paper to expose a substantial number of the internal fibers that were, prior to shearing, coated with polymer. As shown in the figures in the present application, it would

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have been clear to one of ordinary skill in the art that these fibers had been exposed in the shearing process even by a casual inspection of the product. While merely tearing or cutting of poly-coated paper (see, e.g., FIG. 3) would result in partial exposure of a small fraction of the internal fibers (i.e., those along the edges of the tear or cut), the substantial exposure of the fibers due to shearing results in fluffy material with relatively low bulk density and high length-to-diameter ratio. A sample of such texturized material is shown in FIG. 4. The meaning of the phrase "substantial exposure of internal fibers" would be readily apparent to one of ordinary skill in the art.

Applicants respectfully submit that the claim language is indeed definite, and request that the rejection under 35 U.S.C. § 112 be withdrawn.

Rejection under 35 U.S.C. § 102

Claim 7 was rejected under 35 U.S.C. § 102(b) as allegedly anticipated by either or both of U.S. Patent No. 4,020,212 to Erickson ("Erickson") and U.S. Patent No. 5,137,668 to Lamb, Sr. et al. ("Lamb"). Applicants respectfully traverse this rejection.

Applicants agree with the examiner that the patentability of a product-by-process claim depends only on the product, and on its method of production. Nonetheless, Applicants' product is very different from the products described by Erickson and Lamb.

Erickson

As described above, the claims are directed to texturized fibrous material comprising sheared poly-coated paper. Poly-coated paper is defined in the specification, for example, at page 1, line 15, as "paper coated with a polymer." As exemplified at page 1, lines 28-31, the poly-coated paper can also include one or more layers of other materials, such as aluminum. Nonetheless, poly-coated paper always includes paper. According to the ordinary meaning of the term, "paper" is, of course, made from cellulose (see, e.g., page 3, lines 17-18)<sup>1</sup>.

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<sup>1</sup> See also The American Heritage Dictionary, 2nd Edition, which defines the noun "paper" as: "1. A thin sheet material made of cellulose pulp, derived mainly from wood, rags, and certain grasses, processed into flexible leaves or rolls by deposit from an aqueous suspension, and used chiefly for writing, printing, drawing, wrapping, and covering walls. 2. A single sheet of this material. 3. One or more sheets of paper, bearing writing or printing, as: a. an official document. b. An essay, . . . c. An examination . . . or other written academic assignment. d. A newspaper."

The cited Erickson patent describes a fiberfill made of polyolefin fibers treated with a finishing agent that is in turn made of an organopolysiloxane and a surface active softener such as a quaternary ammonium salt. Polyolefins (e.g., polyethylene, polypropylene, and copolymer of ethylene and propylene) are not cellulosic. There is no disclosure whatsoever in Erickson of paper or even of any other cellulosic material. Since Erickson did not disclose this important feature of the claimed invention, the reference could not have anticipated (or rendered obvious) the subject matter of any of the pending claims.

Lamb

Lamb discloses pressboard manufactured from poly-coated paper and "traveling webs" (e.g., non-poly-coated paper). Although Lamb disclosed that the poly-coated paper may be shredded (column 2, lines 63-67), the shredding process described by Lamb would not result in a shearing of the paper to expose internal fibers. Lamb, at column 2, lines 63-68, states that:

... the poly-coated paper is shredded by being passed through a chopper ... which cuts, grinds, mills or otherwise forms the waste paper into pieces which may be approximately three-eighths inch square. Other sizes can be produced depending on the product to be manufactured ...

Even though this citation indicates that "other sizes can be produced," Applicants submit that the fact that the only size pieces that Lamb actually discloses is three-eighths inch square makes it abundantly clear that Lamb did not contemplate a process that shears the poly-coated paper so as to expose the paper's internal fibers. This idea is set forth at paragraph 3 of the February 8, 1999 Declaration of Arthur P. Lagace filed in the parent of the present application, a copy of which Declaration is enclosed herewith.

To shear paper to such an extent requires, for example, optionally grinding the paper into 1/4- to 1/2-inch pieces as shown in FIG. 3 of the application, and then *shearing* (e.g., with a rotary cutter) to produce the "texturized" product. This is explained, for example, in the specification, at page 6, line 27, to page 7, line 13. The resulting texturized poly-coated paper is not simply small squares of paper with ragged edges produced by tearing or ripping, but is a fluffy material capable, for example, of passing through a 2 mm mesh screen. As noted above, FIG. 4 in the application shows a magnified view of such texturized material.

Although Lamb's disclosed 3/8-inch squares concededly fall within the 1/4- to 1/2-inch range disclosed by Applicants for the optional initial grinding of the poly-coated paper, Applicants submit that Lamb's failure to teach or to suggest shearing of the resulting squares precludes the possibility that Lamb could have anticipated (or even rendered obvious) the claimed invention. As mentioned above, all of the pending claims require that the poly-coated paper be sheared to the extent that the internal fibers are substantially exposed. Lamb's "shredded" poly-coated paper would not have substantially exposed internal fibers, since it does not undergo a shearing process.

\* \* \*

In conclusion, neither Erickson nor Lamb anticipates claim 7, and the rejection of the claim under 35 U.S.C. § 102 should be withdrawn.

#### Rejection under 35 U.S.C. § 103

Claims 10 and 11 were rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Erickson or Lamb, Sr. Applicants respectfully traverse this rejection for all of the reasons recited above in traversal of the rejection of claim 7 under 35 U.S.C. § 102. Claims 10 and 11 depend from claim 7 and, therefore, require a texturized fibrous material made from poly-coated paper. Erickson does not suggest a material that includes paper. Lamb does not suggest poly-coated paper having substantially exposed fibers. Accordingly, Applicants request that the rejection of claims 10 and 11 under 35 U.S.C. § 103 be withdrawn.

#### Election/Restriction

The Office Action states that, "applicant did not distinctly and specifically point out the supposed errors in the restriction requirement," and that the election has accordingly "been treated as an election without traverse." As Applicants actually did point out in the Response to Restriction Requirement filed August 21, 2001, the claims of groups III-VI (i.e., claims 8, 9, and 12-36) are all dependent from claim 7. They are drawn to structures, materials, and composites that include the texturized fibrous material of claim 7. By virtue of this fact, the dependent claims would all be patentable if claim 7 is found to be patentable, regardless of which classes or

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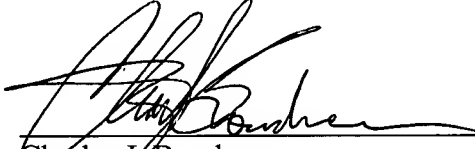
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subclasses they might otherwise belong in. Consequently, Applicants maintain their traversal of the restriction requirement and request that claims 8, 9, and 12-36 be allowed.

Applicant asks that all claims be allowed. Enclosed is a Petition for One Month Extension of Time and a check for the required fee. No other fees are believed to be due at this time. However, please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: February 25, 2002

  
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